

REMARKS

Upon careful and complete consideration of the Office Action dated September 10, 2003, applicants believe that the claims presently on file, when considered in conjunction with the comments herein below, are deemed to place the present application into condition for allowance. Favorable reconsideration of this application is respectfully solicited.

The Office Action has set forth new grounds of rejection. Specifically, the Office Action has rejected claims 1-5, 8 and 12 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,481,364 to Chu et al. (hereinafter referred to as "Chu et al."). The Examiner noted that Chu et al. set forth a reaction where a hydridoalkoxysilane is hydrosilylated with an allyl amine to form aminosilanes with a platinum catalyst. Although the Examiner acknowledged the fact that Chu et al. fail to expressly teach the use of secondary methallylamines in the reaction process, the Examiner concluded that "it would have been obvious to one of ordinary skill in the art at the time of the invention to use secondary methallylamines in the reaction, given the express teaching by Chu in column 3, lines 59-60, that R⁴ may be a methyl group, and the use of secondary amines such as allylaniline in Example 14."

Applicants respectfully disagree with the conclusion drawn by the Examiner. Example 14 of Chu et al. involves the use of N-allylaniline. It is respectfully pointed out that N-allylaniline is an aromatic amine compound. It is respectfully further pointed out that the present invention is directed to a method of preparing a secondary aminoisobutylalkoxysilane comprising hydrosilating a secondary methallylamine with a hydridoalkoxysilane in the presence of an effective amount of a platinum hydrosilation catalyst. That is, the secondary methallylamines of the present invention are clearly aliphatic amine compounds. Thus, the

line of reasoning used in the Office Action to make obvious the present invention as claimed was done so by equating or substituting an aliphatic compound as used by the present invention with an aromatic compound as taught in the cited reference with the.

The differences in physical and chemical properties of aromatic compounds as compared to aliphatic compounds are well documented. It is respectfully submitted that the reasoning used by the Examiner in coming to his conclusion, and ultimately forming the basis for the rejection of the claims, is therefore flawed. One skilled in the art would have no motivation based on the common knowledge difference between aliphatic and aromatic compounds to make the conclusion drawn by the Examiner. Add this to the fact that the subject invention is also dealing with the art of catalysis which is both as a matter of science and as a matter of law unpredictable.


“Lack of obviousness to one having ordinary skill in the art is buttressed by the fact that the claimed invention is a catalytic process. The unpredictability of catalytic phenomena has long been recognized. A successfully catalyzed process depends not only on the particular catalyst that may be employed but also on the environment within which the catalysis is accomplished. The adequacy of any showing of equivalency must be scrutinized especially carefully where it is alleged to have been obvious to substitute one starting material for another in a catalytic process.” **In re Mercier**, 515 F.2d 1161, 185 U.S.P.Q. 774 (C.C.P.A. 1975).

The Office Action has alleged it would be obvious to substitute an aliphatic starting material in the catalytic process of the present invention with an aromatic starting material as taught by Chu et al. in its catalytic process. Such a substitution significantly changes the

environment within which the catalysis is accomplished and one skilled in the art would not be able to predict the outcome of such a substitution with any certainty whatsoever.

Consequently, based on the remarks submitted above, it is respectfully requested that the rejection of the claims under 35 U.S.C. §103(a) be withdrawn. It is respectfully submitted that all the claims in the application, i.e. claims 1-12, contain patentable subject matter and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Edward W. Grolz', with a long, sweeping horizontal stroke extending to the right.

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